

REMARKS

This application is believed to be in condition for allowance at the time of the next Office Action.

The Office Action of February 3, 2011 rejects claims 16-20, 23, 24, and 31-35 under 35 U.S.C. 251 as constituting an improper recapture of subject matter surrendered in the application of the patent upon which the present reissue is based. The Office Action makes no other claim rejection.

The Recapture Rule

"The recapture rule 'prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims.'" Pannu v. Storz Instruments, 258 F.3d 1366, 1370-71 (quoting, In re Clement, 131 F.3d 1464, 1468). "To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection." Id. at 1469 (citations omitted). "Deliberately canceling or amending a claim in an effort to overcome a reference strongly suggests that the applicant admits that the scope of the claim before the cancellation or amendment is unpatentable, but it is not dispositive because other evidence in the prosecution history may indicate the contrary." Id. "The recapture rule does not apply where there is no evidence that amendment of the originally filed

claims was in any sense an admission that the scope of that claim was not in fact patentable." Mentor Corp. v. Coloplast, Inc., 998 F.2d 992, 995-96.

Accordingly, to determine whether impermissible recapture exists, we must first determine what, if any, claimed subject matter was surrendered during prosecution of the original application. Surrender may be inferred from amendment to overcome a rejection based on prior art, but such amendment is not determinative. Moreover, there is no surrender, and by extension there can be recapture, when there is no evidence that amendment of the originally filed claims was an admission that the scope of that claim was not in fact patentable.

Clearly, we must consider the prosecution history of the underlying application.

Prosecution History of the Underlying Application

The present application is for the reissue of U.S. Patent No. 6,267,765, which issued from original application 09/445,176 (the '176 application). The '176 application was filed December 3, 1999. Included with the papers filed December 3, 1999 was a preliminary amendment that canceled all original claims, replacing such with new claims 14-26. Such preliminary amendment, made prior to consideration of the claims on the merits, cannot be construed as a surrender of claimed subject matter.

The first action on the merits in the '176 application was the Office Action of November 16, 2000. This Office Action allowed all but claim 25¹. Claim 25 was rejected on two bases: as indefinite under §112, second paragraph; and as anticipated by Wagner under §102(b). The two rejections are closely interrelated.

The substantive portion of the §112, second paragraph rejection states, in its entirety:

In claim 12 [sic: 25], it is not sure whether applicant is claiming a tool alone or in combination with claim 1. Since applicant is claiming "a tool for positioning the device of claim 1" this passage will not be given any patentable weight. Therefore, claim 12 [sic: 25] will be considered as an independent claim.

In claim 12 [sic: 25], line 11, the term "the cavity" lacks prior antecedent basis.

Commensurate with the position taken by the Examiner as to the asserted impropriety of the dependency of claim 25 from claim 14, claim 25 was construed without consideration of the features of claim 14, from claim 25 nevertheless depended. It is therefore clear that claim 25 as construed and rejected is considerably different from 25 as intended by the Applicant. The record makes clear that Applicant's intent from the outset was

¹ Applicant notes that the language of Office Action refers to claim 12 in both the §112, second paragraph rejection and the §102(b) rejection. However, at the time the Office Action was issued, claim 12 was already canceled, and it is clear from the language of both rejections that the intention was to refer to claim 25. Applicant's remarks in the responsive amendment of February 5, 2001 make this point, and it is believed that this is not in dispute.

for claim 25 to define an invention that included each and every feature and limitation of claim 14.

Entirely consistent with such intent, Applicant responded to the Office Action of November 16, 2000, with the amendment of February 5, 2001. Such amendment modified claim 25 to replace the dependency from claim 14 with a wholesale recitation of the features of claim 14. Such amendment was filed prior to the rule requiring claims amendments to be provided in marked-up form. Accordingly, Applicant includes as an attachment a presentation of the amendment of claim 25 of February 5, 2001 in marked-up form.

In support of the fact that the amendment of claim 25 represents no more than the literal incorporation of the features of claim 14 to replace the implicit incorporation of such features intended by the original claim dependency, Applicant also includes as an attachment a comparison of the new paragraph inserted at the beginning of claim 25 with the text of original claim 14. As is clear from such comparison, the difference consists entirely of: the insertion of appropriate introductory preamble language; the replacement of "of" with "for" for grammatical correction; the insertion of ellipsis in a parenthetical providing reference numerals; and the correction of "centres" into its U.S. spelling.

Accordingly, there can be no dispute that the amendment of claim 25 neither proves nor suggests that the Applicant had

intention to in any way change the scope of claim 25. Quite the contrary, it is abundantly clear that the amendment of claim 25 was merely a matter of form, by which the features of claim 14 that were intended from the outset to be included by way of claim dependency were instead included through literal recitation. From this, we must conclude that claim 25, while amended as to form, was never narrowed. As claim 25 was never narrowed, such amendment cannot constitute surrender. Without surrender, there can be no recapture.

The next action issued by the USPTO in the '176 application was the Notice of Allowance of February 22, 2001, concluding prosecution.

Conclusion

During the entirety of the prosecution of the underlying application, only one claim was rejected. The underlying basis for such rejection is the asserted impropriety of the dependence of the rejected claim from claim 14. Applicant amended the rejected claim by replacing the language establishing such dependency with a wholesale copy of the language of claim 14. Accordingly, the sole rejected claim was never narrowed, and such amendment does not constitute surrender of claimed subject matter, and there can be no recapture.

Should there be any matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below. The Commissioner is hereby authorized in this, concurrent, and future submissions, to charge any deficiency or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17. Respectfully submitted,

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